

REMARKS

The present application was filed on December 28, 2001 with claims 1-49. Independent claims 1, 33-35, 40-41, 46, 48 and 49 have been amended. Claims 1-49 remain pending and claims 1, 33-35, 40-41, 46, 48 and 49 are the pending independent claims.

In the outstanding Office Action dated October 5, 2006, the Examiner: (i) objected to claims 41, 46 and 48; (ii) rejected claims 42 and 46 under 35 U.S.C. §112, second paragraph; (iii) rejected claims 1, 3, 4, 17, 34, 35 and 49 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,931,908 (hereinafter "Gerba"); (iv) rejected claims 41 and 42 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0015986 (hereinafter "Carver"); (v) rejected claims 46-48 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2002/0016965 (hereinafter "Tomsen"); (vi) rejected claim 2 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Carver; (vii) rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of U.S. Patent No. 6,240,555 (hereinafter "Shoff"); (viii) rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Shoff, and further in view of U.S. Patent Publication No. 2005/0273828 (hereinafter "Barton"); (ix) rejected claims 7-10, 12 and 32 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of U.S. Patent No. 6,944,228 (hereinafter "Dakss"); (x) rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of U.S. Patent No. 6,711,552 (hereinafter "Kay"); (xi) rejected claims 13, 15, and 16 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Dakss and Carver; (xii) rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Dakss, Carver, and U.S. Patent Publication No. 2005/0015796 (hereinafter "Bruckner"); (xiii) rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of U.S. Patent No. 6,421,726 (hereinafter "Kenner"); (xiv) rejected claims 19, 36 and 37 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Tomsen; (xv) rejected claims 20, 22, 23, 25, 26 and 28-31 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of U.S. Patent No. 5,878,141 (hereinafter "Daly"); (xvi) rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Daly and Tomsen; (xvii) rejected claim 24 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Daly, and further in view of U.S. Patent Publication No. 2005/0235318 (hereinafter "Grauch"); (xviii) rejected claim 27 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Daly, and further in view of U.S. Patent Publication No. 2002/0053076 (hereinafter "Landesmann"); (xix)

rejected claim 33 under 35 U.S.C. §103(a) as being unpatentable over Tomsen in view of Daly; (xx) rejected claims 38 and 39 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of U.S. Patent Publication No. 2002/0188943 (hereinafter "Freeman"); (xxi) rejected claim 40 under 35 U.S.C. §103(a) as being unpatentable over Shoff in view of Daly; (xxii) rejected claims 43-45 under 35 U.S.C. §103(a) as being unpatentable over Carver in view of U.S. Patent Publication No. 2002/008344 (hereinafter "Blasko"). Applicants respectfully request reconsideration of the present application in view of the amendments above and remarks below.

In regard to the objection to claims 41, 46 and 48, Applicants have amended the claims as suggested by Examiner to correct the informalities. Claim 41 now recites, "at an at least one central system controller" and "at the at least one central system controller." Claim 46 now recites, "at a central system controller" and "from the at least one central system controller." Claim 48 now recites, "at an at least one central system processor of a multi-service operator," "from the at least one central system processor of multi-service operator," and "at the at least one central system processor of a multi-service operator."

In regard to the §112, second paragraph rejection of claims 42 and 46, Applicants have amended claims 42 and 46 to overcome the confusion between the words "processor" and "controller."

In regard to the rejection of claims 1, 3, 4, 17, 34, 35, and 49 under 35 U.S.C §102(b) as being unpatentable over Gerba, Applicants have amended independent claims 1, 34, 35, and 49 to clarify the subject matter of such claims. Claim 1 now recites a "central system processor of a multi-service operator" that "collects information about viewer transactions for commerce purposes." Claims 34 and 35 have been amended to recite a "retrofittable system" for conducting e-commerce over a transaction-enabled broadcast network, said system comprising a central system controller "capable of collecting information about viewer transactions for commerce purposes." Claim 49 now recites an article of manufacture for coordinating interactive television offerings over a transaction enabled broadcast network, the article comprising a computer readable medium containing one or more computer programs, wherein the computer readable medium comprises at least one central system processor of a multi service operator, which when executed implements the step of "collecting information about the transaction for commerce purposes." Support for these

amendments can be found on page 2, lines 7-15, and page 3, lines 8-16 of the Specification. Applicants respectfully assert that these amendments adequately distinguish the claims from Gerba.

In contrast to Examiner's argument, Gerba fails to teach what is recited in independent claims 1, 34, 35, and 49. First, Gerba makes no mention of a central system processor that can control interactive television offerings over a transaction-enabled broadcast network. At most, Gerba makes reference to a transaction processor that "may be coupled to internet servers, databases, computer networks and other components to facilitate the implementation of the various overlay functions selected by users." (Gerba, col. 9, lns. 7-11). This blanket disclosure does not teach what is recited in the independent claims. Secondly, in regard to facilitating e-commerce, Gerba does mention the ability to "buy" or "order" products (Gerba, col. 1, lns. 20-39); however, Gerba only teaches a system of cuing the viewer to "actionable events" where the user is directed to the world wide web to purchase items. This differs from the claims where a central processor processes viewer request data directly rather than simply pointing the user to a website. Finally, Gerba does not teach a central system controller capable of collecting information about viewer transactions for commerce purposes. Gerba only teaches a method of programming actionable events. For at least these reasons, independent claims 1, 34, 35, and 49 are not anticipated by Gerba.

Dependent claims 3, 4 and 17 are patentable at least by virtue of their dependency from independent claim 1, and recite patentable subject matter in their own right. Accordingly, Applicants therefore respectfully request withdrawal of the §102(b) rejection of claims 1, 3, 4, 17, 34, 35 and 49.

In regard to the rejection of claims 41 and 42 under 35 U.S.C. §102(e) as being anticipated by Carver, Applicants amended independent claim 41 to clarify the subject matter of the claim. Claim 41 now recites a method of conducting e-commerce over a transaction-enabled broadcast network, said method comprising, creating an advertisement comprising non-interactive content, said advertisement being broadcast over said network at an at least one central system controller, and creating interactive content, said additional interactive content being selectively integrated with said non-interactive content according to a predetermined schedule at the at least one central system controller, wherein the at least one central system controller collects information about consumer transactions resulting from the interactive content, for commerce purposes. Support for the amendment can be found on page 2, lines 7-15, and page 3, lines 8-16 of the Specification. Applicants respectfully assert that the amendment adequately distinguishes the claim from Carver.

In contrast to Examiner's argument, Carver does not teach a method of conducting e-commerce by integrating interactive content with non-interactive content via a central system controller as recited in claim 41. Examiner mistakenly equates the "central system controller" with an "Interactive Advertising Service." Applicants respectfully assert that the two terms are not the same. Carver fails to explain in detail how interactive content is incorporated with non-interactive content. Carver simply discloses that an Interactive Advertising Service (IAS) will cooperate with other services, like an interactive delivery service, "to insert, replace, aggregate, compose, and so forth, the interactive content delivery with advertising." (Carver, pg. 7, para. 97). Applicants assert that this vague reliance on secondary services to incorporate interactive advertising does not teach a central system controller that both integrates interactive content with non-interactive content and facilitates e-commerce over a transaction-enabled broadcast network. Further, Carver does not teach a central system controller that collects information about consumer transactions resulting from the interactive content, for commerce purposes. For at least these reasons, independent claim 41 is not anticipated by Carver.

Dependent claim 42 is patentable at least by virtue of its dependency from independent claim 41, and also recites patentable subject matter in its own right. Accordingly, Applicants therefore respectfully request withdrawal of the §102(e) rejection of claims 41 and 42.

In regard to the rejection of independent claims 46-48 under 35 U.S.C. §102(e) as being anticipated by Tomsen, Applicants have amended independent claims 46 and 48 to clarify the subject matter of such claims. Claim 46 now recites a central system controller that collects information about consumer transactions resulting from the interactive content, for commerce purposes. Claim 48 now recites a method of conducting e-commerce over a transaction-enabled broadcast network that also collects information about the transaction for commerce purposes. Support for these amendments can be found on page 2, lines 7-15, and page 3, lines 8-16 of the Specification. Applicants respectfully assert that these amendments adequately distinguish the claims from Tomsen.

In contrast to Examiner's argument, Tomsen only teaches a method and system of saving content for deferred transaction via interactive television. Tomsen does not teach a central system that can both create broadcast content comprising conventional and interactive content, and broadcast that content for e-commerce purposes. As in Examiner's other references, Tomsen relies

on multiple parties to incorporate interactive content, broadcast the content, receive request data from viewers, and process request data. Furthermore, none of Examiner's references, including Tomsen, describe a central system that collects data about viewer transactions for commerce purposes. For at least these reasons, independent claims 46 and 48 are not anticipated by Tomsen.

Dependent claim 47 is patentable at least by virtue of its dependency from independent claim 46, and also recites patentable subject matter in its own right. Accordingly, Applicants therefore respectfully request withdrawal of the §102(e) rejection of claims 46-48.

In regard to the rejection of independent claim 33 under 35 U.S.C. §103(a) as being unpatentable over Tomsen in view of Daly, Applicants amended independent claim 33 to clarify the subject matter of the claim. Claim 33 now recites a retrofittable system for conducting e-commerce over a transaction-enabled broadcast network, said system comprising, a broadcast receiving device operatively coupled to said network and configurable to enable a viewer to interact with an interactive broadcast, and a local multi-service operator operatively coupled to said network, said local multi-service operator comprising a central system controller, said central system controller being operatively configurable to tabulate commerce transactions occurring over said network, wherein the tabulation involves collecting transaction data for network operators. Support for this amendment can be found on page 2, lines 7-15, and page 3, lines 8-16 of the Specification. Applicants respectfully assert that the amendment adequately distinguishes the claim from Tomsen and Daly.

Independent claim 33 is patentable for at least the reasons stated above with regard to the §102(e) rejection in light of Tomsen. In addition, Tomsen does not describe a retrofittable system capable of tabulating transaction data for network operators. In regard to Daly, Examiner concedes that Daly does "not explicitly disclose that the controller tabulates or lists the purchase transactions or commerce transactions." However, examiner argues that it would have been obvious to one of ordinary skill in the art to include the controller to be "operatively configurable to determine purchasing information occurring over the network as taught by Daly in order to allow a consumer to electronically pay for goods and services in a manner to protect the merchant and purchaser from fraudulent purchases as disclosed by Daly." Applicants respectfully disagree. First, neither the specification nor the claims specifically state that the reason to tabulate transaction data is to protect the merchant and purchaser from fraudulent purchases. Second, tabulating commerce transactions to

protect against fraudulent purchases is not the only reason to tabulate transaction data. *See* Specification, page 2, lines 7-15, and page 3, lines 8-16. Applicants respectfully assert that regardless of the reasons to tabulate commerce transactions, neither Tomsen nor Daly teach a central system controller being operatively configurable to tabulate commerce transactions occurring over a network, wherein the tabulation involves collecting transaction data for network operators; therefore, claim 33 is not unpatentable over Tomsen in view of Daly. Accordingly, Applicants therefore respectfully request withdrawal of the §103(a) rejection of claim 33.

In regard to the rejection of independent claim 40 under 35 U.S.C. §103(a) as being unpatentable over Shoff in view of Daly, Applicants amended independent claim 40 to clarify the subject matter of the claim. Claim 40 now recites a retrofittable system for conducting e-commerce over a transaction-enabled broadcast network, said system comprising, a broadcast receiving device operatively coupled to said network and configurable to enable a viewer to interact with an interactive broadcast, and a local multi-service operator operatively coupled to said network, said local multi-service comprising a central system controller, said central system controller operatively configurable to tabulate data based on commerce activities conducted by a viewer on said network, wherein the tabulation can be used by network operators for commerce purposes. Support for this amendment can be found on page 2, lines 7-15, and page 3, lines 8-16 of the Specification. Applicants respectfully assert that the amendment adequately distinguishes the claim from Shoff and Daly.

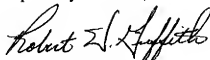
In contrast to Examiner's argument, Shoff in view of Daly fails to teach a retrofittable system for conducting e-commerce over a transaction-enabled broadcast network comprising a central system controller operatively configurable to tabulate data based on commerce activities conducted by a viewer on said network, wherein the tabulation can be used by network operators for commerce purposes. First, neither Shoff nor Daly teach a retrofittable system for conducting e-commerce over a transaction-enabled broadcast network. Secondly, Examiner concedes that Shoff is "silent on the author or operator comprising a controller and the controller configurable to tabulate transactions occurring over the network." Examiner argues that it would have been obvious to one in the ordinary skill in the art that Shoff would be modified "to include the controller being operatively configurable to tabulate or index data based on purchasing information occurring over the network as taught by Daly in order to allow a consumer to electronically pay for goods and services as disclosed

by Daly.” Applicants respectfully disagree. “It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” MPEP §2144.03(E). Applicants respectfully assert that Shoff in view of Daly fails to teach what is recited in independent claim 40; therefore, claim 40 is not unpatentable over Shoff in view of Daly. Accordingly, Applicants therefore respectfully request withdrawal of the §103(a) rejection of claim 40.

In regard to the §103(a) rejections of dependent claims 2, 5-16, 18-32, 36-39 and 43-45 as being unpatentable over the references distinguished above in view of multiple secondary references, Applicants assert that the multiple secondary references fail to remedy the deficiencies of the references distinguished above. Thus, dependent claims 2, 5-16, 18-32, 36-39 and 43-45 are patentable at least by virtue of their dependency from independent claims 1, 35 and 41, and also recite patentable subject matter in their own right. Accordingly, Applicants therefore respectfully request withdrawal of the §103(a) rejections of claims 2, 5-16, 18-32, 36-39 and 43-45.

In view of the above, Applicants believe that claims 1-49 are in condition for allowance, and respectfully request withdrawal of the §112, §102 and §103 rejections.

Respectfully submitted,



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